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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,585	03/18/2004	Kathleen Nylund Jackson	47079-00299USPT	7261
70243	7590	12/01/2008		
NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER HU, KANG	
			ART UNIT 3715	PAPER NUMBER
			MAIL DATE 12/01/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,585	<b>Applicant(s)</b> JACKSON, KATHLEEN NYLUND	
	<b>Examiner</b> KANG HU	<b>Art Unit</b> 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 15-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 15-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/18/2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. Current office action is in response to amendment filed 8/13/2008, claims 1 and 21 have been amended, claims 9, 11-14, and 22 have been cancelled, claims 1-8, 10, 15-21 and 23-28 are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10, 15-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, Jr. et al. (Us 6,887,154 B1) in view of Acres et al. (US 6,319,125).

Re claim 1, previously indicated in office action dated 5/14/2008, Luciano teaches a method of playing a gaming system played by a plurality of players where a jackpot is awarded, the method comprising: players playing an underlying wagering game in which wagers are made by players; when an outcome occurs in the underlying wagering game that identifies that a jackpot is to be awarded to at least one of said players, entering a special bonus event for all of said players presently playing the underlying wagering game (abstract, col 2: 20-67; col 3, 1-17; col 4, 29-60; col 6: 32-49), the special bonus event providing a chance to be awarded bonuses; However Luciano does not explicitly teach randomly selecting bonuses to be awarded in the special bonus event; and randomly selecting more than one but less than all of said players to be awarded the

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randomly selected bonuses and excluding at least one player from being awarded any bonus, said randomly selected bonuses being in addition to any awards some of said players may win continued play of the underlying wagering game. Luciano teaches that players who have an active status at the time of the progressive award triggering event are entitled to share in the secondary progressive prize (col 3: 1-13) are analogies to all of said players presently playing the underlying wagering game. Acres teaches when the player wins the game, a jackpot equaling some multiple of wager in the form of coins, tokens or credits are awarded. Additionally bonus prizes are awarded as part of bonus promotions, such bonus promotions can be tiered into a main bonus prize and multiple secondary bonus prizes, plus optional consolation prizes and similar combinations. Seven different forms and combinations of bonuses are awarded to the player including cash, participation (mystery) progressive and multiple jackpot, welcome back, match play and personal progressive bonus prizes; each of which are controlled by a different bonus server and separate from the jackpot prize. After specific trigger events, randomly selecting bonuses to be awarded in the special bonus event; and randomly selecting more than one but less than all of said players to be awarded the randomly selected bonuses). It would have been obvious for one of ordinary skill in the art at the time of the invention to have thought about the different distribution to attract additional players to the machine as stated by both Acres and Luciano.

Claims 2-8, 10, and 15-20 have been addressed in the previous action and are also rejected by Luciano in view of Acres, specific sections cited in the previous action.

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Claims 21 and 23-28, the method of playing a gaming system played by a plurality of players where a jackpot is awarded is substantially the same as claims 1-8, 10, 15-20 discussed above and will not be repeated herein.

### ***Response to Arguments***

4. Applicant's arguments filed 8/13/2008 have been fully considered but they are not persuasive. The applicant has argued that “for each of the cash bonus, mystery bonus and progressive bonus forms, the bonus prize is awarded to selected eligible players, while all the remaining players are awarded a fixed consolation prize. The examiner respectfully disagrees with the argument provided by the applicant, as cited in office action, Acre teaches of (The bonus prize can be tiered into a main bonus prize and multiple secondary bonus prizes, plus optional consolation prizes, and “similar combinations.” the claims above) Col 4, lines 30-32. The examiner best understood it to mean that the consolation prize is not given to all eligible players as the consolation prize is optional. Furthermore, col 5, lines 41-43 also recite “a consolation prize is awarded at all active gaming devices except the winning gaming device”, also excluding at least one player from being awarded any bonus.

Applicant further argues “randomly selecting bonuses to be awarded in the special bonus event”, that Acres fails to teach randomly selecting bonuses, the examiner respectfully disagrees, with mystery bonus prize, Acres teach that there's are three kinds of mystery bonuses to be awarded, first a car is awarded when the value of the bonus pool substantially equals a lucky number falling between ten thousand and forty thousand. In addition, progressively larger secondary cash

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prizes ranging between \$100 and \$400 and consolation prizes of \$50 are also awarded. (Col 6, lines 19-24). The examiner best understood these prizes to be awarded randomly instead of simple one bonus jackpot argued by the applicant. Therefore the examiner asserts that the combination of Luciano in view of Acres teaches the invention as claimed by the applicant.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kang Hu/  
Examiner, Art Unit 3715

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715